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EXAMINER	
ELAHEE, MD S	

ART UNIT	PAPER NUMBER
2645	

DATE MAILED: 12/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/892,964	BANERJEE ET AL.	
	Examiner	Art Unit	
	Md S Elahee	2645	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *03* MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-25* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-25* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. Examiner has received an after final amendment and additional declaration from Mr. Emile filed on 09/22/04. Examiner does not agree with the arguments in the remarks of the amendment that the evidence submitted overcomes the effective date of the McCormack et al. reference. The reasons are shown below. However, examiner has performed an updated search and found a new prior art reference Bilder. In light of the reference, the finality of previous action has been withdrawn and examiner has made new ground of rejection in view of Bilder.

Response to Argument

2. The evidence submitted is insufficient to establish a conception of the invention prior to the effective date of the McCormack et al. reference. In other words, the complete claimed invention was not conceived prior to the date of the McCormack reference because Exhibit A or B fails to support a complete disclosure of claims 1-25. For example,

"the content is a web page from a web server on the Internet" as recited in claim 1;

"the web page is downloaded to the cell phone from the web server after being converted into a wireless application protocol format by a gateway coupling the Internet to the digital wireless telecommunications network" as recited in claim 4;

"the html of the web page is converted into wireless markup language by the gateway" as recited in claim 5;

"after the voice call is placed in an on hold status, a voice message is played to the user via the cell phone requesting the user to select the download of the content" as recited in claim 6;

"the downloading step further comprises the step of using caller ID pertaining to the cell phone to select a particular content to download to the cell phone" as recited in claim 7;

"the voice call and the download of the content are performed in parallel over a connection between the cell phone and the network using a packet switched protocol" as recited in claim 8;

"discontinuing the downloading of the content when the on hold status is discontinued" as recited in claim 9.

"the content is a web page from a web server on the Internet" as recited in claim 11;

"after the voice call is placed in an on hold status, a voice message is played to the cell phone requesting the user to authorize the download of the content" as recited in claim 13;

"the downloading program step further comprises the program step of using caller ID pertaining to the cell phone to select a particular content to download to the cell phone" as recited in claim 14;

"the program step of: discontinuing the downloading of the content when the on hold status is discontinued" as recited in claim 15;

" An information handling system comprising:

a database storing html code for displaying a web page on a web enabled phone;

a switch for coupling to a telecommunications network and for connecting an extension to a cell phone over the telecommunications network; and

an application server for downloading the web page to the web enabled phone in parallel with a voice conversation occurring between the extension and the cell phone" as recited in claim16;

"a gateway coupled between the application server and the telecommunications network for

converting the html code of the web page to wireless markup language so that the web page can be displayed on a display screen of the web enabled phone" as recited in claim 17;

"the telecommunications network between the cell phone and the switch comprises a bearer wireless network and a public switched telephone network" as recited in claim 18;

"the gateway is coupled to the cell phone via the bearer wireless network" as recited in claim 19;

" the telecommunications network is packet switched permitting parallel downloads" as recited in claim 20;

"A telecommunications network comprising:

a digital wireless network;

a switch;

a public switched telephone network coupled to the switch and to the digital wireless network;

a telephone device coupled to the switch;

circuitry for creating a voice connection between the web enabled telephone and the telephone device via the digital wireless network, public switched telephone network, and the switch; and

an application server for downloading content to the web enabled telephone in parallel with occurrence of the voice connection" as recited in claim 21;

"the content is a web page formatted for display on a display screen of the web enabled telephone" as recited in claim 22;

"a wireless application protocol gateway for converting html code of the web page received

from the application server into wireless markup language for transmission to the web enabled telephone over the digital wireless network" as recited in claim 23.

3. The applicant argues on page 6, lines 5-7 of amendment filed on 09/22/04 that there is no need to show diligence between March 21, 2001 and April 11, 2001. Examiner disagrees with this argument. According to MPEP 715.07, under 37 CFR 1.131, the critical period in which diligence must be shown begins just prior to the effective date of the reference or activity that ends with the date of a reduction to practice. Furthermore, according to MPEP 2138.06, diligence requires that applicants must be specific as to dates and facts and the period during which diligence is required must be accounted for by either affirmative acts or acceptable excuses. The newly submitted declaration of Volel Emile submitted is insufficient to establish diligence from a date prior to the date of reduction to practice of the McCormack et al. reference to either a constructive reduction to practice or an actual reduction to practice. For example, from Exhibit A to Exhibit J, there is insufficient diligence since the Examiner cannot determine the date of Exhibit A and Exhibit B. Further, No evidence to show diligence between 03/21/2001 to 04/11/2001. Further, within the laps period, the applicant does not show any activity.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-15, 21, 22, 24 and 25 are rejected under 35 U.S.C. 102(e) as being anticipated by McCormack et al. (U.S. Pub. No. 2002/0136384).

Regarding claims 1 and 10, McCormack teaches receiving a voice call from a mobile caller (i.e., user of a cell phone) (abstract; fig.2; page 4, paragraph 0070).

McCormack further teaches conducting a voice conversation with the mobile caller (i.e., user of a cell phone) (abstract; fig.2; page 4, paragraph 0070).

McCormack further teaches while maintaining the voice call with the mobile caller (i.e., user of a cell phone), downloading content to the mobile handset (i.e., cell phone) for browsing on a browser (i.e., display on a display screen) of the mobile handset (abstract; fig.2; page 4, paragraphs 0070, 0072, 0073).

Regarding claims 2 and 11, McCormack teaches the content is a web page from a web server on the Internet (abstract; fig.2; page 4, paragraphs 0073, 0074).

Regarding claims 3, 12 and 24, McCormack teaches placing the voice call in an on hold status, wherein the downloading step is performed while the voice call is in the on hold status (abstract; fig.2; page 4, paragraphs 0070, 0072-0074).

Regarding claim 4, McCormack teaches the web page is downloaded to the cell phone from the web server after being converted into a wireless application protocol format by inherently a gateway coupling the Internet to the digital wireless telecommunications network (fig.2; page 4, paragraphs 0070, 0072-0074).

Regarding claim 5, McCormack teaches the html of the web page is inherently converted into wireless markup language by the gateway (abstract; fig.2; page 4, paragraphs 0070, 0072-0074).

Regarding claims 6 and 13, McCormack teaches after the voice call is placed in an on hold status, a voice message is played to the user via the cell phone requesting the user to select the download of the content (abstract; fig.2; page 4, paragraphs 0070, 0072-0074).

Regarding claims 7 and 14, McCormack teaches using inherently caller ID pertaining to the cell phone to select a particular content to download to the cell phone (fig.2; page 4, paragraphs 0070, 0072-0074).

Regarding claim 8, McCormack teaches that the voice call and the download of the content are performed in parallel over a connection between the cell phone and the network using a packet switched protocol (abstract; fig.2; page 4, paragraphs 0070, 0072-0074).

Regarding claims 9 and 15, McCormack teaches discontinuing the downloading of the content when the on hold status is discontinued (page 4, paragraph 0073).

Regarding claim 21 is rejected for the same reasons as discussed above with respect to claim 1. Furthermore, McCormack teaches a wireless (i.e., digital wireless) network (fig.2).

McCormack teaches a router (i.e., switch) (fig.2).

McCormack further teaches a public switched telephone network coupled to the switch and to the digital wireless network (fig.2; page 2, paragraph 0044).

McCormack further teaches a telephone device coupled to the switch (fig.2).

Regarding claim 22 is rejected for the same reasons as discussed above with respect to claim 1.

Regarding claim 25, McCormack teaches that the mobile caller (i.e., web enabled telephone) browsing (i.e., displaying) the content simultaneously with the voice connection (page 4, paragraphs 0070, 0072, 0073).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7. Claims 16-20 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over McCormack et al. (U.S. Pub. No. 2002/0136384) and in view of Tobita et al. (U.S. Pub. No. 2002/0009987).

Regarding claim 16, McCormack teaches browsing (i.e., displaying) a web page on a web enabled phone (fig.2; page 4, paragraphs 0073, 0074).

McCormack further teaches a router (i.e., switch) for coupling to a local area network (i.e., telecommunications network) and for connecting an extension to a mobile phone (i.e., cell phone) over the local area network (fig.2; page 4, paragraph 0070).

McCormack further teaches an application server for downloading the web page to the web enabled phone in parallel with a voice conversation occurring between the extension and the mobile phone (i.e., cell phone) (fig.2; page 4, paragraphs 0070, 0072, 0073).

McCormack fails to teach "a database storing html code". Tobita teaches a database storing html code (fig.12; page 8, paragraphs 0117, 0118). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify McCormack to allow a database storing html code as taught by Tobita. The motivation for the modification is to have doing so in order to provide the user with a link to the HTML mail storage.

Regarding claim 17, McCormack teaches that the web page can be displayed on a display screen of the web enabled phone (fig.2; page 4, paragraphs 0070, 0072, 0073).

McCormack fails to teach "a gateway coupled between the application server and the telecommunications network for converting the html code of the web page to wireless markup language". Tobita teaches a gateway coupled between the application server and the telecommunications network for converting the html code of the web page to wireless markup language (fig.1; page 3, paragraph 0032). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify McCormack to allow a gateway coupled between the application server and the telecommunications network for converting the html code of the web page to wireless markup language as taught by Tobita. The motivation for the modification is to have doing so in order to transmit the request to the contents server.

Regarding claim 18, McCormack teaches that the telecommunications network between the cell phone and the switch comprises a bearer wireless network and a public switched telephone network (fig.2; page 2, paragraph 0044, page 4, paragraphs 0070, 0072, 0073).

Regarding claim 19, McCormack fails to teach "the gateway is coupled to the cell phone via the bearer wireless network". Tobita teaches that the gateway is coupled to the cell phone via the bearer wireless network (fig.1; page 3, paragraph 0032). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify McCormack to allow the gateway coupled to the cell phone via the bearer wireless network as taught by Tobita. The motivation for the modification is to have doing so in order to convert an intrinsic identifier of a mobile phone added to the request and transmit the request to the contents server.

Regarding claim 20, McCormack teaches that the telecommunications network is packet switched permitting parallel downloads (fig.2; page 4, paragraphs 0070, 0072, 0073).

Regarding claim 23 is rejected for the same reasons as discussed above with respect to claim 16.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

9. Claims 1-4, 6-15, 21, 22, 24 and 25 are rejected under 35 U.S.C. 102(e) as being anticipated by Bilder (U.S. Patent No. 6,400,804).

Regarding claims 1 and 10, Bilder teaches receiving a voice call from a user of a cell phone (abstract; fig.1, 3, 4; col.2, lines 12-18, col.3, lines 15-27).

Bilder further teaches conducting a voice conversation with the user of a cell phone (col.3, lines 15-27).

Bilder further teaches while maintaining the voice call with the user of a cell phone, downloading content to the cell phone for display on a display screen of the cell phone (fig.1, 3, 4, 6; col.2, lines 12-18, col.3, lines 15-27, col.4, lines 23-34, col.9, lines 20-50). (Note; since the terminal can browse internet, it is inherent that the terminal can download content to the terminal for display on a display screen of the terminal)

Regarding claims 2 and 11, Bilder teaches that the content is a web page inherently from a web server on the Internet (col.3, lines 15-27, col.4, lines 23-34, col.9, lines 20-50).

Regarding claims 3, 12 and 24, Bilder teaches placing the voice call in an on hold status, wherein the downloading step is inherently performed while the voice call is in the on hold status (col.3, lines 15-27, col.4, lines 23-34, col.9, lines 20-50).

Regarding claim 4, Bilder teaches that the web page is downloaded to the cell phone from the web server after being converted into a wireless application protocol format by inherently a gateway coupling the Internet to the digital wireless telecommunications network (col.3, lines 15-27, col.4, lines 23-34, col.9, lines 20-50).

Regarding claims 6 and 13, Bilder teaches after the voice call is placed in an on hold status, a voice message is played to the user via the cell phone requesting the user to select the download of the content (fig.4; col.6, lines 55-61).

Regarding claims 7 and 14, Bilder teaches using inherently caller ID pertaining to the cell phone to select a particular content to download to the cell phone (col.8, lines 14-23).

Regarding claim 8, Bilder teaches that the voice call and the download of the content are performed in parallel over a connection between the cell phone and the network using a packet switched protocol (col.2, lines 12-29, col.3, lines 15-27, col.4, lines 23-34, col.9, lines 20-50).

Regarding claims 9 and 15, Bilder teaches discontinuing the downloading of the content when the on hold status is discontinued (col.3, lines 45-60).

Regarding claim 21 is rejected for the same reasons as discussed above with respect to claim 1. Furthermore, Bilder teaches a wireless network (col.2, lines 12-29).

Bilder teaches a switch (col.2, lines 36-42).

Bilder further teaches a public switched telephone network coupled to the switch and to the digital wireless network (fig.1; col.2, lines 3-54).

Bilder further teaches a telephone device coupled to the switch (fig. 1; col.2, lines 3-54).

Regarding claim 22 is rejected for the same reasons as discussed above with respect to claim 1.

Regarding claim 25, Bilder teaches that the web enabled telephone displaying the content simultaneously with the voice connection (col.3, lines 15-27, col.4, lines 23-34, col.9, lines 20-50).

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

11. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bilder (U.S. Patent No. 6,400,804) and in view of Villart et al. (U.S. Pub. No. 2002/0046185).

Regarding claim 5, Bilder does not specifically teach "the html of the web page is converted into wireless markup language by the gateway". Villart teaches that the html of the web page is converted into wireless markup language by the gateway (page 3, paragraph 0026). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Bilder to allow the html of the web page being converted into wireless markup language by the gateway as taught by Villart. The motivation for the modification is to have doing so in order to provide communication between two dissimilar communication protocols.

12. Claims 16-20 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bilder (U.S. Patent No. 6,400,804) and in view of Tobita et al. (U.S. Pub. No. 2002/0009987).

Regarding claim 16, Bilder teaches displaying a web page on a web enabled phone (col.3, lines 15-27, col.4, lines 23-34, col.9, lines 20-50).

Bilder further teaches a switch for coupling to a local area network (i.e., telecommunications network) and for connecting an extension to a cell phone over the local area network (fig.1; col.2, lines 3-54).

Bilder further teaches an application server for downloading the web page to the web enabled phone in parallel with a voice conversation occurring between the extension and the cell phone (fig.1; col.2, lines 3-54, col.3, lines 15-27, col.4, lines 23-34, col.9, lines 20-50).

Bilder fails to teach "a database storing html code". Tobita teaches a database storing html code (fig.12; page 8, paragraphs 0117, 0118). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Bilder to allow a database storing html code as taught by Tobita. The motivation for the modification is to have doing so in order to provide the user with a link to the HTML mail storage.

Regarding claim 17, Bilder teaches that the web page can be displayed on a display screen of the web enabled phone (col.3, lines 15-27, col.4, lines 23-34, col.9, lines 20-50).

Bilder fails to teach "a gateway coupled between the application server and the telecommunications network for converting the html code of the web page to wireless markup language". Tobita teaches a gateway coupled between the application server and the telecommunications network for converting the html code of the web page to wireless markup language (fig.1; page 3, paragraph 0032). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Bilder to allow a gateway coupled between the application server and the telecommunications network for converting the html code

of the web page to wireless markup language as taught by Tobita. The motivation for the modification is to have doing so in order to transmit the request to the contents server.

Regarding claim 18, Bilder teaches that the telecommunications network between the cell phone and the switch comprises a bearer wireless network and a public switched telephone network (fig.1; col.2, lines 3-54).

Regarding claim 19, Bilder fails to teach "the gateway is coupled to the cell phone via the bearer wireless network". Tobita teaches that the gateway is coupled to the cell phone via the bearer wireless network (fig.1; page 3, paragraph 0032). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Bilder to allow the gateway coupled to the cell phone via the bearer wireless network as taught by Tobita. The motivation for the modification is to have doing so in order to convert an intrinsic identifier of a mobile phone added to the request and transmit the request to the contents server.

Regarding claim 20, Bilder teaches that the telecommunications network is packet switched permitting parallel downloads (fig.1; col.2, lines 3-54, col.3, lines 15-27, col.4, lines 23-34, col.9, lines 20-50).

Regarding claim 23 is rejected for the same reasons as discussed above with respect to claim 16.

Conclusion

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

U.S. Patent No. 6,556,670 (Horn) - note Figs. and Abstract;

U.S. Patent No. 6,526,041 (Shaffer et al.) - note Figs. and Abstract;,

U.S. Patent No. 5,991,374 (Hazenfield) - note Figs. and Abstract;

U.S. Patent No. 5,946,378 (Farfan) - note Figs. and Abstract;

U.S. Patent No. 6,208,729 (Agraharam et al.) - note Figs. and Abstract.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Md S Elahee whose telephone number is (703)305-4822. The examiner can normally be reached on Mon to Fri from 8:30am to 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on (703)305-4895. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

M.E.

MD SHAFIUL ALAM ELAHEE
November 26, 2004

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